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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,368	12/04/2001	Takayuki Iida	1982-0174P	9776
2292	7590	12/29/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NGUYEN, HUNG	
			ART UNIT	PAPER NUMBER

2851

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,368

Applicant(s)

IIDA, TAKAYUKI

Examiner

Hung Henry V Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Response 9/16/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 29-50 is/are pending in the application.
- 4a) Of the above claim(s) 31-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/4/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 31-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claims are related to an image print order recording method and a print processing method (see claims 31 and 44 for example) where the order information is encoded, classified in class 396 subclass 429 while original claims 1-7 are related to a print processing method for carrying out print processing, classified in class 355, subclass 77.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 3, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hicks (U.S.Pat. 5,359,387).

With respect to claims 3, 5 and 7, Hicks discloses a photographic process method for carrying out print process in which an image which corresponds to a visible image recorded on an image recording medium is formed, onto a new recording medium/final photographic print and the method comprising all of the limitations of the instant claims including steps of recording inputted order condition and process conditions as order information onto the image recording medium and forming image which is formed on the image recording medium onto a new image recording medium on the basis of the order information (see abstract and fig.2).

4. Claims 1-7, and 29-30 are rejected under 35 U.S.C. 102 (e) as being anticipated by Ueda et al (U.S.Pat. 6,429,923).

With respect to claims 3, 5 and 7, Ueda et al discloses an photofinishing method for carrying out print processing in which an image which corresponds to a visible image recorded on an image recording medium/film (16) is formed, onto a new image recording medium/ such as: photographic printing paper/a CD/PC card/computer...etc", and comprising all basic steps as set forth in the instant claims such as: recording inputted order conditions and processing conditions/photofinishing instructions onto an image medium on which the visible image is formed-(see col-79,-lines-60-through-col:80,-lines-8) and-forming-the-image-which-is-formed-on the image recording medium onto a photographic paper/new image medium based on the order information (see col.80, lines 35-39).

As to claims 1-2 and 6, Ueda further teaches a scanner (170, 600) for reading the image which is formed on the image recording medium and the monitor (190) for displaying the image which is formed on the image recording medium and computer (100) for changing the displayed image by carrying out image processing on the basis of processing condition which are set in accordance with inputted order condition and a printer for forming the image recording medium onto a new image recording medium on the basis of the order information. (see col.35, lines 12-39).

As to claims 29-30, Ueda teaches the processing condition including composite processing and index print/geometric processing and order condition including number of prints (see col.37 lines 1-20).

Response to Arguments

5. Applicant's arguments with respect to prior art rejections have been carefully reviewed but they are not found to be persuasive. The applicant is reminded that the claimed subject matter to examination will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not be read into the claims. In re Yamamoto, 740 F. 2d 1569, 1571, 222 USPO 934, 936 (Fed.Cir. 1984). With this in mind, the discussion herein will focus on how the terms and relationships thereof in the claims are met by the references.—Response to any limitation that is not in the claims or any argument that is irrelevant to or does not relate to any specific claimed language will not be warranted.

In response to Applicant's arguments that Hicks does not teach "recording inputted order conditions and processing conditions as order information onto the image recording medium on

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which the visible image is formed”; the Examiner respectfully disagrees with the Applicant since Hicks meets all of the limitations as claimed. For example, at least, Hicks discloses the number of prints (which can be regarded as “order condition” in the broadest sense) and the “print size” or “composition data” (which can be regarded as “processing condition in the broadest sense) being recorded as order information on to the image recording medium on which the visible image is formed.

With respect to the rejection under the art of Ueda, Applicant argues that Ueda requires that the order information is transmitted to a server to be processed while the claims call for “the order information is stored on an image recording medium”; the Examiner respectfully disagrees with the Applicant because as mentioned above “the claimed subject matter to examination will be given their broadest reasonable interpretation”. In general, “an image recording medium” is understood as a medium in which an image is recorded. As such, unless otherwise stated, it is not in error to interpret that “a server/or computer, or compact disk,, floppy disk or video tape or PC card” can be regarded as “an image recording medium” as broadly claimed. The Applicant is reminded that it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.* 7USPQ2d 1064.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this

~~Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).~~

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Henry V Nguyen whose telephone number is 703-305-6462. The examiner can normally be reached on Monday-Friday (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on 703-308-2847. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

hvn
12/7/03



HENRY HUNG NGUYEN
PRIMARY EXAMINER